UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,562	09/25/2001	Bryson Gordon	NAI1P140/01.131.01	3082

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EXAMINER
POLTORAK, PIOTR

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/965,562	GORDON ET AL.
	Examiner	Art Unit	
	Peter Poltorak	2134	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *13 September 2005*.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4-6,9-10,13,19-20,23,27-29 and 42-44* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4-6,9-10,13,19-20,23,27-29 and 42-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some *　c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. The Amendment, and remarks therein, received on 3/30/2005 have been entered and carefully considered.

Response to Amendment

2. Applicant's arguments have been carefully considered.

3. In regard to the limitation: "wherein the certificate includes a link to a web site describing the virus scanning performed on the e-mail by including a type and version of a virus scanner utilized in scanning the e-mail for viruses" applicant argues that "Suffolk simply prints the type and version of the virus scanner as a footer on the email, and thus there is no link to a web site describing the virus scanning performed on the specific e-mail", and the web link included in the AVG certificate provides information on the software used to perform the virus scanning.

4. The examiner finds the arguments not persuasive and points to the Suffolk that provides a link http://www.grisoft.com above the type and version of the virus scanner.

5. Upon visiting the web site (using Internet Archive WayBack Machine) referred by the link, the examiner found information describing the virus scanning performed on the e-mail (e.g. it is performed by the product built utilizing Virtual Device Driver Technology). It also provides the AVG Tutor (available on the same web site) that offers more information on the scanning implemented by the software *(e.g. AVG Tech)*.

6. Selecting AVG Tutor takes a reader to AVG 6.0 section of the web site.

Selecting "AVG E-mail scanner" from the index menu allows the reader to learn that during scanning "any incoming or outgoing e-mail and its attachments" are scanned "to verify that they were virus free", for example *(AVG 9)*.

Thus, this particular section alone describes virus scanning performed by the same anti-virus software that was used in Suffolk's e-mail scanning.

7. It is clear from the AVG web site (referred by the link included in the AVG certificate) that not only it describes the scanning by elaborating on the software used in the scanning but also it describes the process itself, e.g. in addition to e-mail one should expect e-mail attachments to be free of viruses as well.

8. Applicant argues the obviousness of incorporating Fisher's digital signature into *AVG* in view of *Fisher* invention. In particular, applicant argues that the digital signature in *Fisher* is added to a software program by a manufacturer to prove authenticity so that a current digital signature may be compared with the original digital signature added by the manufacturer in order to see if the program has been tampered with.

9. The examiner finds the arguments not persuasive and points out that the feature of checking whether a code (program, message etc.) has been tampered with would be an ideal addition to *AVG* product especially since it takes time from the completion of scanning e-mail to reception of e-mail by the designated recipient. In addition e-mail not only travels through many nodes but also is handle by multiple program. These conditions make e-mail a subject very much vulnerable to any potential attacks that could affect the e-mail messages and attachments, e.g. infecting them with new

viruses. As a result certification without the validity of integrity of the scanned e-mail

could be essentially useless.

Just for these reasons alone it would have been obvious to one of ordinary skill in

the art at the time of applicant's invention to implement *Fisher 's* digital signature in

AVG in view of *Fisher* invention

10. Applicant argues attaching the certificate at the server stating that Chen does not

teach the limitation.

11. The examiner points out that *AVG* in view of *Fisher* teach attaching a certificate.

The certificate is attached at the computer that handles e-mail (e.g. scanning e-

mail). A computer that handles e-mail sending it once a user gives a command to

send reads on e-mail server. Furthermore, even if the computer were not to be

consider as a server, some kind of server that handles e-mail delivery is inherently

necessary in e-mail exchange between a sender and a recipient.

12. The examiner provides explicit example of such a server. Chen teaches an e-mail

server handling scanning and sending e-mail *(Chen et al., Abstract)*.

It would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to incorporate scanning e-mail at the server as taught by *Chen et al.* One

of ordinary skill in the art would have been motivated to perform such a modification

in order to avoid computer problems and to avoid the necessity of installing anti-virus

software on all workstations *(Chen et al., col. 4 lines 41-55)*.

13. Lastly, the examiner points out that implementing of e-mail scanning on a computer

or a server is a design choice and it would not affect the functionality of the

invention.

14. As per incorporating the virus scanner within a mail application that is utilized in

creating the e-mail applicant argues that a virus scanner simply being compatible

with a mail applications is not the same as virus scanner being incorporated within

the mail application.

15. The examiner finds the arguments not persuasive.

16. Although *AVG* does not explicitly teach incorporating the virus scanner within a mail

application that is utilized in creating the e-mail, *AVG* does teach compatibility with

MS Outlook clients and Exchange clients *(Avg 9)*. Also, the *AVG's* product in

addition to be compatible it also complements e-mail applications. As a result it

would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to incorporate the virus scanner within an e-mail application. One of

ordinary skill in the art would have been motivated to perform such a modification in

order to scan and certify e-mails handled by the application as virus free.

17. Claims 1, 4-6, 9-10, 13, 19-20, 23, 27-29 and 42-44 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

18. Claims 1, 4-6, 9-10, 13, 19-20, 23, 27-29 and 42-44 are rejected under 35 U.S.C.

112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter that applicant regards as the invention.

19. The claim 1, 19 and 27 recites: "wherein the certificate includes a link to a web site

describing the virus scanning performed on the e-mail by including a type and a

version of a virus scanner....".

20. It is not clear whether it is the certificate, the link or the web site that describes the

virus scanning. Similarly, it is not clear whether it is the certificate, the link or the

web site that includes a type of version of a virus scanner.

21. Applicant should rewrite the claim language so that there is no ambiguity.

22. Claim 13 depends on cancelled claim 11.

23. Claims rejected by virtue of their dependence 4-6, 9-10, 20, 23, 28-29 and 42-44.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

24. Claims 1, 4, 6, 9-10, 13, 19-20, 23, 27-29 and 44 are rejected under 35 U.S.C.

103(a) as being unpatentable over *AVG (AVG anti-virus)* as evidenced by *AVG*

Tech, AVG 9, Suffolk-L and *Microscopy* in view of *Fisher (U.S. Patent No. 5311591)*

and in further view of *Chen et al. (U.S. Patent No. 5832208)*.

25. As per claims 1 and 27 *AVG* teaches a certificate added to e-mail sent from a

computer to a recipient, the certificate identifying the e-mail as being scanned for

viruses and certifying that no viruses were found *(AVG 9)*.

AVG certificate includes a web link (http://www.grisoft.com), and virus type and

version *(Suffolk)*. Upon visiting the web site (using Internet Archive WayBack

Machine) referred by the link, the examiner found information describing the virus

scanning performed on the e-mail in addition to the AVG Tutor (available from the

web site) providing more information on the software *(e.g. AVG Tech)*.

This reads on wherein the certificate includes a link to a web site describing the virus

scanning performed on the e-mail by including a type and version of a virus scanner

utilized in scanning the e-mail for viruses.

26. *AVG* in view of *Fisher* does not teach attaching a digital signature.

Fisher teaches attaching a digital signature and teaches a content recipient verifying

that no tampering occurred *(Fisher, col. 16 lines 9-23)*.

It would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to attach a digital signature in order to provides means of verification that

content has not been tampered with. One of ordinary skill in the art would have been

motivated to perform such a modification in order to verify that no virus infection
occurred *(Fisher, col. 16 lines 9-23)*.

27. *AVG* in view of *Fisher* and *Chen et al.* do not teach that the virus scanner is
incorporated within a mail application that is utilized in creating the e-mail.

28. *AVG* does teach compatibility with MS Outlook clients and Exchange clients *(Avg 9)*.
In addition the *AVG's* product in addition to be compatible it also complements e-
mail applications. As a result it would have been obvious to one of ordinary skill in
the art at the time of applicant's invention to incorporate the virus scanner within an
e-mail application. One of ordinary skill in the art would have been motivated to
perform such a modification in order to scan and certify e-mails handled by the
application as virus free.

29. *AVG* in view of *Fisher* and *Chen et al.* do not explicitly teach that the computer is a
network server and that attaching the certificate comprises attaching the certificate
at the server.

30. *Chen et al.* teach the computer that is a server scanning and sending e-mail *(Chen
et al., Abstract)*.

31. It would have been obvious to one of ordinary skill in the art at the time of applicant's
invention to incorporate scanning e-mail at the server as taught by *Chen et al.* One
of ordinary skill in the art would have been motivated to perform such a modification
in order to avoid computer problems and to avoid the necessity of installing anti-virus
software on all workstations *(Chen et al., col. 4 lines 41-55)*.

32. As per claim 19 *AVG* in view of *Fisher* and *Chen et al.* does not explicitly teach anti-virus database for use by the antivirus application.

Official Notice is taken that it is old and well-known practice to configure anti-virus application to use anti-virus database *(e.g. virus definition database Symantec 1, quarantine database, Symantec 2)*. One of ordinary skill in the art at the time of applicant's invention would have been motivated to configure anti-virus application to use anti-virus database in order to check characteristics of known viruses and to store (in quarantine) e-mail that can not be repaired or contain suspect components.

33. As per claims 4 and 44 *AVG* checks any outgoing e-mail and its attachments *(Avg 9)*.

34. As per claims 6 and 23 *Chen et al.* teach scanning e-mail messages received over the Internet (*Chen et al., Abstract*)

35. As per claim 28 *AVG* in view of *Fisher* and *Chen et al.* does not explicitly teach that the computer codes (implementing the invention) are stored on a medium selected from the group consisting of CD-ROM, floppy disk, tape, flash memory, system memory or a hard drive.

Official Notice is taken that it is old and well-known practice to use CD-ROM, floppy disk, tape, flash memory, system memory or a hard drive as a medium and one of ordinary skill in the art at the time of applicant's invention would have been motivated to employ such a medium given the benefit of inexpensive and proven/reliable technology.

36. As per claim 29 *AVG* in view of *Fisher* and *Chen et al.* does not explicitly teach

cleaning infecting data.

Official Notice is taken that it is old and well-known practice to clean infecting data.

It would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to clean infecting data. One of ordinary skill in art at the time of applicant's

invention would have been motivated to clean infected data to prevent computer

problems.

37. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *AVG (AVG*

anti-virus) as evidenced by *AVG Tech, AVG 9, Suffolk-L* and *Microscopy* in view of

Fisher (U.S. Patent No. 5311591) and *Chen et al. (U.S. Patent No. 5832208)* and in

further view of *ACS (ACS Microcomputer Workshop, "Message management in*

Outlook for Windows", 1999).

38. *AVG* in view of *Fisher* teaches scanning and sending e-mail as discussed above.

AVG in view of *Fisher* does not explicitly teach the e-mail being scanned

automatically when a user sends the e-mail.

39. *ACS* teaches automatic scanning (default spell check option) when e-mail is sent

(Spell Checking a message).

It would have been obvious to one of ordinary skill in the art at the time of applicant's

invention to scan e-mail automatically when a user sends the e-mail as taught by

ACS. One of ordinary skill in the art would have been motivated to perform such a

modification in order to take advantage of a main computing strong point: tasks

automation.

40. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over *AVG (AVG anti-virus)* as evidenced by *AVG Tech, AVG 9, Suffolk-L* and *Microscopy* in view of *Fisher (U.S. Patent No. 5311591)* and *Chen et al. (U.S. Patent No. 5832208)* and in further view of *BBBOnLine* as evidenced by *Findarticles.com,* and *Alarm.*

41. *AVG* in view of *Fisher* teaches the certificate as discussed above.

    AVG in view of *Fisher* does not teach that the certificate contains only graphical images and that it includes a company logo.

42. *Findarticles.com* teach including a company logo in the graphical image of the certificate, and the teaching is illustrated by *Alarm.*

    It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include a company log in the certificate. One of ordinary skill in the art would have been motivated to perform such a modification in order to allow a viewer a quick recognition of the certifying party.

43. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over *AVG (AVG anti-virus)* as evidenced by *AVG Tech, AVG 9, Suffolk-L* and *Microscopy* in view of *Fisher (U.S. Patent No. 5311591)* and *Chen et al. (U.S. Patent No. 5832208)* and in further view of *Peter Williams "Digital Certificates, Applied Internet Security", 1998, ISBN: 0201309807).*

44. *AVG* in view of *Fisher* teaches a certificate as discussed above. *AVG* in view of *Fisher* does not teach a certificate containing graphics and text.

45. *Feghhi et al.* teach a certificate containing graphics and text *(Feghhi et al., pg. 151 Fig. 5-21).*

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to utilize the certificate containing graphics and text as taught by *Feghhi et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to clearly identify the certificate and provide additional information pertaining to the certificate while limiting space used (text takes less space than graphics).
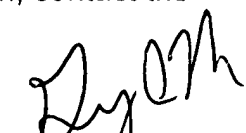
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571) 272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/14/05